
FULL TEXT OF CASES (USPQ FIRST SERIES)
In re GARDNER, 178 USPQ 149 (CCPA 1973)

In re GARDNER

(CCPA)
178 USPQ 149

Decided June 14, 1973

No. 8923

U.S. Court of Customs and Patent Appeals

Headnotes

PATENTS

1. Specification — Claims as disclosure (§ 62.3)

Original claim is adequate "written description" (first paragraph of 35 U.S.C. 112) of claimed invention since there is adequate disclosure of a much broader class of compounds in main body of specification; it is equally a "written description" whether located among original claims or in descriptive part of specification; In re Marzocchi, 157 USPQ 504, and In re Cavallito, 134 USPQ 370, are distinguished in that there was insufficient support for claims in sense of enabling disclosure in specification.

Particular patents—Compound

Gardner, Guanidinoalkylbenzodioxan Derivatives, rehearing denied.

Case History and Disposition:

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Appeal from Board of Appeals of the Patent Office.

Application for patent of John Nicholson Gardner, Serial No. 679,670, filed Nov. 1, 1967; Patent Office Group 122. From decision rejecting claim 2, applicant appealed. Reversed at 177 USPQ 396. On petition for rehearing. Petition denied.

Attorneys:

ALAN D. LOURIE, Philadelphia, Pa. (WILLIAM A. SMITH, JR., Arlington, Va., of counsel) for appellant.

S. WM. COCHRAN (JACK E. ARMORE of counsel) for Commissioner of Patents.

Judge:

Before MARKEY, Chief Judge, RICH, BALDWIN, and LANE, Associate Judges, and ALMOND, Senior Judge.

Opinion Text

Opinion By:

MARKEY, Chief Judge.

The Commissioner has petitioned for rehearing and reconsideration with respect to our reversal of the § 112 rejection based on the first paragraph description requirement. Our view that original claim 2 in itself constituted sufficient "description in the original disclosure" of a subgenus within the broad class of guanidinoalkyl1-1 : 4-benzodioxan derivatives disclosed in the application to satisfy the description requirement has been challenged.

The Commissioner's basic contention is succinctly stated at page 6 of the petition as follows:

While an original claim may be considered as a part of the original *disclosure*, it should not be considered a part of the "written description"—unless the specification contains or is amended to contain the subject matter of the original claim.

[1] A conflict is alleged with our holdings in *In re Marzocchi*, 55 CCPA 1084, 394 F.2d 571, 157 USPQ 504 (1968), and *In re Cavallito*, 49 CCPA 1335, 306 F.2d 505, 134 USPQ 370 (1962). In those cases, however, although the rejected claims were original claims and thus part of the original disclosure, there was insufficient support for claims of such breadth, in the sense of enabling disclosure in the specification. Here there is an adequate disclosure of a much broader class of compounds in the main body of the specification, as recognized in our earlier opinion, and the only question lies in the delineation of the particular subgenus now being claimed. Under these circumstances, we consider the original claim in itself adequate "written description" of the claimed invention. It was equally a "written description" whether located among the original claims or in the descriptive part of the specification. Whether the descriptive part of the specification should be amended to include the language of claim 2 is more of an administrative matter to be settled in the Patent Office and is not a proper basis for our decision on the merits of this rejection. We simply note that appellant has offered to make such an amendment.

The petition for rehearing or reconsideration is *denied*.

- End of Case -

